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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,272	04/08/2004	Daniel F. D'Elena	END920040009US1	2174
40412 7590 05/12/2008 IBM CORPORATION- AUSTIN (JVL) C/O VAN LEEUWEN & VAN LEEUWEN PO BOX 90609 AUSTIN, TX 78709-0609				
EXAMINER FLEISCHER, MARK A				
ART UNIT		PAPER NUMBER		
4143				
MAIL DATE		DELIVERY MODE		
05/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/822,272

**Applicant(s)**

D'ELENA ET AL.

**Examiner**

MARK A. FLEISCHER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☒ Claim(s) 2, 9 and 15 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 8 April 2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the Application filed on 8 April 2004.
2. Claims 1–20 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statements filed on 8 April 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Objections***

4. Claims 2, 9 and 15 are objected to because of the following informalities: The claim limitations use the phrase "in response to the matching" where the use of the word "response" seems inappropriate. Examiner suggests that other phraseology might make the text clearer and have the same effect. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to *one or more core skills, wherein each core skill corresponds*, but it is not clear whether a *core skill* must correspond to only one *user* or whether each user can be associated with a set of core skills. The wording of this limitation therefore is vague and

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indefinite. For purposes of examination Examiner will interpret this to mean that each user may be associated with a particular set of core skills. Examiner believes this is basically a grammatical error and easily remedied.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- a) Determining the scope and contents of the prior art.
- b) Ascertaining the differences between the prior art and the claims at issue.
- c) Resolving the level of ordinary skill in the pertinent art.
- d) Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 5, 6, 8, 12–14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui (20030229529 A1) in view of Miller (US 20030110067 A1).

**Claims 1, 8 and 14:**

Although claims 1, 8 and 14 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui, as shown, describes and/or discloses the following limitations.

- *retrieving one or more core skills, wherein each core skill corresponds to each of a plurality of users* (Mui, in at least [0972] states: "Information Distributor [ ] can locate and deliver a wide variety of resources [and] supports a wide variety of descriptive

information required by business applications, from standard web metadata to catalog information to skills and competencies." (emphasis added) where 'information' that is 'deliver[ed]' must, *ipso facto* be *retriev[ed]* and where 'catalog...' corresponds to *core skills*. Note that this also that this pertains to records of *each of a* as described in the abstract: "The method comprises establishing competency records, person records, and building desired goal profile records. Competencies identified in person records are compared to required competencies identified in goal profile records to identify best fit persons to utilize in achieving a goal.");

Mui does not specifically describe and/or disclose the following limitations, but Miller, as shown, does.

- retrieving a subset of dimension skills from a plurality of dimension skills, wherein the subset of dimension skills correspond to a subset of the plurality of users* (Miller, in at least [0073] states: "Returning to FIG. 2G, the next task in the mini-assessment and appraisal is to assess the development of an onsite schedule, step 262. The core of the assessment during step 260 is made up of the onsite period, which usually lasts from five to ten days. The onsite period consists of three basic activities: (1) gathering information through interview sessions with project leaders, team leaders, and functional area representatives; (2) mapping information to processes areas within the scope of the assessment through consolidation sessions [...]" and in [0094] states: "The competency model definition will document the knowledge, skills and other attributes/abilities associated with high performance on a job. The roles, jobs, teams and organizational structures will document the responsibilities associated with: the individual (roles), groups of related roles (jobs), groups of jobs (teams) and the span of control, reporting relationships and functional relationships [...]. In designing a competency model [...], the organization should group together related competencies to form a competency model. A competency is skills, and other attributes/abilities associated with high performance on a job; and a competency

model is a group of related competencies required to perform a career field such as team leader or technical coach. Similarly, [...], the organization defines the roles played by individuals, the jobs they hold, the teams in which they work, and the relationship between teams. The organization should logically define roles for individuals on the basis of their competencies. [...]" (emphasis added) where 'group together...' and 'competency model is ...' corresponds to a *subset of dimension skills*...Note that 'gathering information...' and 'mapping information' as disclosed corresponds to *retrieving a subset*...);

Mui further describes and/or discloses the following limitations.

- *identifying a progression requirement for each of the core skills and the subset of dimension skills; including the retrieved core skills, the subset of dimension skills, and the identified progression requirements in a framework* (Mui, in at least [1285] states: "The Performance Application may utilize goal records to monitor progress on the goal, assign goals to person, and identify Competencies associated with the goal. Each goal record may be associated with a subgoal profile record or parent goal record, and each subgoal or parent record may have additional levels of subgoals or parents, with each subgoal record or parent goal record identifying competencies and associated competency levels helpful in achieving the desired subgoal or parent goal." (emphasis added). Although Mui does not specifically refer to a *progression requirement* as disclosed in the specification, Miller does in at least [0001] wherein he states: "...a method for assisting and expediting an organization's progression through the levels of the Capability Maturity Model (CMM)." (emphasis added) where 'progression' and 'levels' corresponds to a *subset of dimension skills*...Also, in at least [0096] Miller states: "(3) designing career progression...to reward individuals for desired contributions." (emphasis added) where 'contributions' corresponds to those associated with a *subset of dimension skills* to which their competencies make 'contributions'.); and

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- *evaluating one of the plurality of users using the framework, the evaluating resulting in an evaluated user* (Mui, in at least claim 11 states: "[...] held competency level by a person is determined from evaluations such as personal assessments, test, and courses." (emphasis added) where the emphasized text collectively constitutes a framework or structure for assessing a user.).

Mui describes and/or discloses a method for "enterprise workforce planning" and Miller describes and/or discloses a type of "process improvement framework" wherein users or employees are given a roadmap to assist in organizational transformation. Mui describes ways to assess individuals and Miller provides the framework by which there are controlled improvements in organizational competence. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions of Mui and Miller to establish a system and method to develop an array of skill sets so that a workforce is better trained and management is better informed as to how to best to utilize the competencies of the workforce.

**Claims 5, 12 and 18:**

Although claims 5, 12 and 18 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui and Miller describe and/or disclose the limitations of claims 1, 8 and 14 as shown above. Mui further describes and/or discloses the following limitations.

- *the subset of dimension skills constitutes a first dimension skills module, the method further comprising:*
  - *selecting one or more dimension skills from the plurality of dimension skills, the selecting resulting in a second dimension skills module* (Mui, in at least [1289] states: "A Goal Metric supports a finite number of measurement units or categories. and can optionally relate to a set of Competencies that might be needed to affect the metric in a meaningful way." (emphasis added) and in at least [1291] further describes various 'categories' of skills.); and

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- *replacing the first dimension skills module with the second dimension skills module in the framework* (Mui, in at least [1357] states: "The Rating Providers submit their feedback in the form of ratings and comments on various aspects of the individual performance: Goal Assignments, Job and Goal Competencies, and any other competencies judged pertinent for the review." (emphasis added) where 'rating providers submit' corresponds to *replacing the first dimension skills module* and 'various aspects...' corresponds to the *first and second dimension skills module[s]*. Note that the effect of utilizing 'various aspects' is equivalent in its effect as *replacing* since it involves consideration of other 'aspects' *i.e., dimensions* of skill level assessments.).

**Claims 6, 13 and 19:**

Although claims 6, 13 and 19 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui and Miller describe and/or disclose the limitations of claims 1, 8 and 14 as shown above. Mui further describes and/or discloses the following limitations.

- *identifying one or more functional skills that correspond to the subset of dimension skills* (Mui, in at least [1232] states: "An organization's business goals [ ] may be specific goals at any level: enterprise, business unit, function, project, or department level. By disaggregating the organizational goals into smaller segments [...] a user [...] can determine the required goals [ ] for each jobholder. These segmented goals drive job definitions and required competencies which the jobholder must possess for the organization to achieve these goals." (emphasis added) where the 'function' corresponds to a *functional skill* per the 'required competencies' and 'disaggregating ...' corresponds to the act of *identifying one or more functional skills...* since that process is used to define and hence identify.); *and*
- *including the identified functional skills in the framework* (Mui, in at least [1214] states: "The Performance module [...] defines the services available for managing



human performance, including competencies, goals, and feedback services [...]" (emphasis added) where the 'defined' set of competencies is 'included' in the 'performance module' hence *the identified functional skills [are included] in the framework.*).

10. Claims 2–4, 7, 9–11, 15–17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui/Miller as applied to claims 1, 8 and 14 and further in view of Magrino (US 20020198765 A1).

**Claims 2, 9 and 15:**

Although claims 2, 9 and 15 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui and Miller describe and/or disclose the limitations of claims 1, 8 and 14 as shown above. Mui/Miller do not specifically describe and/or disclose the following limitations, but Magrino, as shown, does.

- *retrieving a user capability, the user capability corresponding to the evaluated user* (Magrino, in at least [0084] states: "The underlying knowledge base for the engine [ ] is again preferably stored and retrieved from the key phrase database [ ], though in a form most appropriate for use by the engine [ ]" (emphasis added) where in [0034] the "work preferences, skills, accomplishments, and other work and life-style attributes of the individual, together reflecting the value of the individual as a member of the workforce, are collectively referred to as performance capabilities." (emphasis added) where 'retrieved from...' corresponds to *retrieving* and 'work preferences...' and 'individual' and 'capabilities' corresponds to a *user capability*. Note that in [0046] this pertains to a data set of one who is "evaluated");
- *matching the user capability with one of the progression requirements that are included in the framework* (Magrino, in at least [0082] refers to "matching against position specifications and cumulative scoring." Where in [0078] the "performance capability skills held and any skill level rankings assessed by the candidate may be

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approved..." (emphasis added) where 'skill level' corresponds to *progression requirements*); and

- *ranking the evaluated user in response to the matching, the ranking resulting in a skill ranking* (see the text of the previous paragraph where 'rankings assessed' corresponds to *ranking the evaluated user...*).

Mui describes and/or discloses a method for "enterprise workforce planning" and Miller describes and/or discloses a type of "process improvement framework" wherein users or employees are given a roadmap to assist in organizational transformation. Mui describes ways to assess individuals and Miller provides the framework by which there are controlled improvements in organizational competence. Magrino further provides a framework for matching up required skill levels with capabilities of users. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions of Mui, Miller and Magrino to establish a system and method to develop and effectively assign an array of skills and skill sets so that a workforce is better trained and management is better informed as to how to best to utilize the competencies of the workforce.

### **Claims 3, 10 and 16:**

Although claims 3, 10 and 16 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui, Miller and Magrino describe and/or disclose the limitations of claims 2, 9 and 15 as shown above. Mui further describes and/or discloses the following limitations.

- *computing the skill ranking for each of the core skills and each of the subset of dimension skills, the computing resulting in a plurality of skill rankings* (Mui, in at least [1357] states: "The Rating Providers submit their feedback in the form of ratings and comments on various aspects of the individual performance: Goal Assignments, Job and Goal Competencies, and any other competencies judged pertinent for the review." (emphasis added) where the emphasized text corresponds to the limitation.); and

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- *establishing an overall ranking based upon the plurality of skill rankings* (Mui, in at least [1358] states: "Once all the data is gathered, an overall rating is calculated--a value that can be overridden by the manager while the review is open." (emphasis added) where the emphasized text corresponds to the limitation.).

**Claims 4, 11 and 17:**

Although claims 4, 11 and 17 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui, Miller and Magrino describe and/or disclose the limitations of claims 3, 10 and 16 as shown above. Mui further describes and/or discloses the following limitations.

- *identifying one or more user improvement areas, wherein the user improvement area corresponds to one of the core skill or one of the dimension skill which requires the user to improve in order to increase the user's overall ranking* (Mui, in at least [0213] states: "Competency gap analysis can be applied to either an individual's goals [ ] or roles [ ]. The analysis compares the required competencies for reaching a goal [ ] or filling a role [ ] (either held or targeted) to actual held competencies and generates a competency gap [ ]. Learning interventions [...] that fill the competency gap [ ] are the [sic] identified." (emphasis added) where the 'competency gap analysis' corresponds to *identifying one or more user improvement areas*...Note that in [1331] it states: "Ranking determined by total competency proficiency gap ..." which implies that a *user ...improve in order to ...*).

**Claims 7 and 20:**

Although claims 7 and 20 are worded and/or structured slightly differently, they have the same scope and so are addressed together. Mui and Miller describe and/or disclose the limitations of claims 1, 8 and 14 as shown above. Mui and Miller do not describe and/or disclose the following limitations, but Magrino, as shown, does.

- *wherein the framework is selected from the group consisting of a profession-specific framework and a business function-specific framework* (Magrino, in at least [0058]

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states: "Professional Skills: category fields are provided to permit entry of specific work experience, knowledge and training, certifications, and degrees and other professional qualifications received. Categorized fields can be provided to permit entry of specific professional qualifications, which are prerequisites for specific, typically professional positions, or required for maintenance of a typically professional position, such as mandatory continuing education credits." (emphasis added). Miller describes and/or discloses the following elements of the aforementioned limitations. Miller, in at least [0211] states: "The organization performs step [ ] to identify the functional, technical, and performance requirements for the technology infrastructure that should support the solution [... and...] identifies key performance indicators, [...]" (emphasis added) where 'professional skills: category...' corresponds to the *profession-specific [skills] framework* and 'functional' and 'performance requirements...' corresponds to the *business-specific framework*).

Miller describes and/or discloses a process improvement framework that incorporates business-specific categories and measures for evaluating human resources while Magrino describes and/or discloses categories for measuring profession-specific skills and competencies. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions of Miller and Magrino so that organizations can assess both professional skill levels and business-specific skill levels and thereby obtain a more detailed and hence useful skill-profile of their workforce.

11. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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***Conclusion***

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Dr. Mark A. Fleischer** whose telephone number is **571.270.3925**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** whose telephone number is **571.272.6710** may be contacted.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Examiner, Art Unit 4143

7 May 2008

/James A. Reagan/

Supervisory Patent Examiner, Art Unit 4143